

### REMARKS

Claims 1-8, 10-16, and 54-57 are currently under examination. Claims 1-7, 10-16, 54 and 56 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1-8, 10-16, and 54-57 stand rejected under 35 U.S.C. § 102(b). Each of these rejections is addressed as follows.

#### **Claims rejections – 35 U.S.C. § 112**

Claims 1-7, 10-16, 54 and 56 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. For the following reasons, this rejection should be withdrawn.

Applicant has amended claims 1, 54, and 56 to each require a nucleic acid molecule encoding a polypeptide having at least 95% identity to the polypeptide of SEQ ID NO:1. Support for this amendment is found, for example, on page 5 (line 9) of the specification. The scope of the claims is now limited to sequences that are highly identical, and therefore necessarily structurally similar, to the disclosed sequence (SEQ ID NO:1). In addition, applicant submits that the specification provides an adequate written description of the nucleic acid molecules required for use in the claimed method. Accordingly, the section 112, paragraph one rejection should be withdrawn.

No new matter has been added by any of these amendments, and applicant notes, for the record, that the current claim amendments were made solely for the

purpose of expediting prosecution. Applicant reserves the right to pursue all canceled subject matter in this or future related applications.

### **Claim rejections – 35 U.S.C. § 102**

Claims 1-8, 10-16, and 54-57 remain rejected under 35 U.S.C. §102(b) as anticipated by Sheen (WO 98/26045), for reasons of record. Applicant respectfully disagrees.

Applicant has previously amended claim 1 to recite that a transgene that overexpresses a nucleic acid molecule encoding a calcium dependent protein kinase (CDPK) polypeptide is introduced into a plant cell that is “susceptible to a disease-causing pathogen.” As is described below, the cited reference fails to teach or suggest this step of introducing the nucleic acid molecule into a plant cell that is “susceptible to a disease-causing pathogen”, and accordingly, does not anticipate claim 1.

As an initial matter, Applicant notes that, to anticipate claim 1, WO 98/26045 each must disclose every limitation of the claimed method, either explicitly or inherently. *Glaxo Inc. v. Novapharm Ltd.*, 52 F.3d 1043, 1047 (Fed. Cir. 1995). In order for a disclosure to be inherent, the missing descriptive matter must necessarily be present in the prior art reference such that one skilled in the art would recognize such a disclosure. This requirement was clearly stated in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268-1269 (Fed. Cir. 1991) (Emphasis added.):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described

in the reference, and that it would be so recognized by persons of ordinary skill. *In re Oelrich*, 666 F.2d 578, 581, 212USPQ 323, 326 (CCPA 1981)(quoting *Hansgirk v. Kemmer*, 102 F.d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) provides:

Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

It is not inherent in the disclosure of WO 98/26045 that the plant cells used for the transformation experiments were either susceptible to a disease causing pathogen or would become resistant to a disease-causing pathogen upon introduction of the nucleic acids falling within the scope of claim 1. The cited reference is silent on these issues, and there is no evidence indicating that plant cells susceptible to disease-causing pathogens are necessarily present.

In addition, the mere possibility that WO 98/26045 might be understood by one of skill in the art to disclose plant cell susceptible to a disease-causing organism is insufficient to show that it is inherently disclosed in the reference. WO 98/26045 does not satisfy the standard for inherency. As stated above by the Federal Circuit, “inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” The anticipation rejection should therefore be withdrawn.

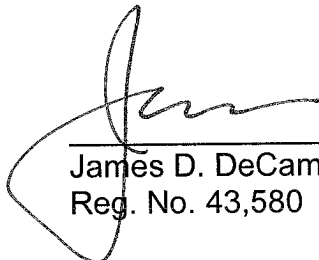
CONCLUSION

Applicant submits that the claims are in condition for allowance, and such action is respectfully requested.

Enclosed is a Petition to extend the period for replying to the Office action for three (3) months, to and including August 9, 2006. If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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